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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,107	03/31/2004	Joseph C. Coffey	2316.1834US01	5190
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Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER SEMENENKO, YURIY	
			ART UNIT 2841	PAPER NUMBER

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,107

Applicant(s)

COFFEY ET AL.

Examiner

Yuriy Semenenko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/6/04:8/22/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 drawn to a patch panel, classified in class 361 subclass 788.
- II. Claims 14 and 15 drawn to a method of patching telecommunications cables, classified in class 29 subclass 825.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of using that product. For example, the product can be used in process which does not required circuit module.

1.3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

1.4. During a telephone conversation with S. C. Bruess (Reg. No. 34,130), on December 16, 2005, a provisional election without traverse was made to prosecute the invention of Group I, claims 1-13, drawn to a patch panel. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 14 and 15 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.1. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/871698. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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2.2. With respect to claims 1 and 8 claim 1 and 10 of Application No.

10/871698 teaches all of the limitations exactly except:

1. claims 1 and 8 disclose : “mounted to the front major surface of the back plane” and only “mounted to the back plane ” in claims 1 and 10 of Application No. 10/871698, respectively. However this limitations in claims 1 and 10 of Application No. 10/871698 still reads on claims 1 and 8 of application.

2.3. Claim 1 correspond to claim 1 of Application No. 10/871698. Claim 2 correspond to claim 2 of Application No. 10/871698. Claim 3 correspond to claim 3 of Application No. 10/871698. Claim 4 correspond to claim 4 of Application No. 10/871698. Claim 5 correspond to claim 5 of Application No. 10/871698. Claim 6 correspond to claim 6 of Application No. 10/871698. Claim 7 correspond to claim 7 of Application No. 10/871698. Claim 8 correspond to claim 10 of Application No. 10/871698. Claim 9 correspond to claim 11 of Application No. 10/871698. Claim 10 correspond to claim 12 of Application No. 10/871698. Claim 11 correspond to claim 13 of Application No. 10/871698 Claim 12 correspond to claim 14 of Application No. 10/871698. Claim 13 correspond to claim 15 of Application No. 10/871698.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jennison (Patent #6535602) hereinafter Jennison.

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As to claim 1: Jennison discloses in Fig. 1 and 2 a patch panel comprising: a back plane 1 having a front major surface and, a back major surface facing in an opposite direction; a plurality of pairs of termination locations 4 and 2 mounted to the back plane 1, each termination location including a patch cord access device (for instance, telephone jack) defining electrical contacts connected to the back plane for electrically connecting to conductors in a patch cord; a plurality of interconnect locations 3 mounted to the back plane, each interconnect location defining a card edge socket with normally connected contact pairs connected to the back plane; circuitry on the back plane 1 for connecting each termination location 4 and 2 of each pair to one of the interconnect locations (column 3, lines 24-31).

As to claim 2: Jennison discloses the patch panel of claim 1, wherein one of the pairs of termination locations includes two RJ45 jacks (column 2, lines 12-17 and column 3, lines 31-35) .

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4.1. Claims 5- 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennison, and further in view of Carlson et al. (Patent # RE37125) hereinafter Carlson.

As to claim 8: Jennison discloses in Fig. 1 and 2 a patch panel comprising: a back plane 1 having a front major surface and a back major surface; a plurality of pairs of termination locations 4 and 2 mounted to the front major surface of the back plane 1, each termination location including a patch cord access device (e.g. telephone jack) defining electrical contacts connected to the back plane for electrically connecting to conductors in a patch cord; a plurality of interconnect locations 3 mounted to the front major surface of the back plane; circuitry on the back plane 1 for connecting each termination location 4 and 2 of each pair to one of the interconnect locations (column 3, lines 24-31),

except , Jennison doesn't explicitly teach at least one removable circuit module mounted to one of the interconnect locations, the removable circuit module including circuitry connected to interconnect location for connecting to one of the pairs of termination locations.

Carlson discloses in Fig. 1 at least one removable circuit module 22 mounted to one of the interconnect locations 20, the removable circuit module including circuitry connected to interconnect location 20 for connecting to one of the pairs of termination locations 30 32 (column 5, lines 18-28).

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made, for Jennison to include in his invention that at least one removable circuit module mounted to one of the interconnect locations, the removable circuit module including circuitry connected to interconnect location for connecting to one of the pairs of termination locations, as taught by Carlson

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because Carlson teaches that such a configuration would provide an interface between a utility distribution network and subscriber owned equipment (column 2, lines 22-26).

As to claim 9: Carlson discloses the patch panel having all of the claimed features as discussed above with respect claim 8, wherein one of the pairs of termination locations includes two RJ45 jacks column 2, lines 12-17 and column 3, lines 31-35).

As to claim 5: Carlson discloses the patch panel having all of the claimed features as discussed above with respect claim 1,

except , Jennison doesn't explicitly teach the patch panel comprising a module defining an edge contact sized for receipt in one of the card edge sockets, of one of the interconnect locations.

Carlson discloses in Fig. 1 the patch panel 16 comprising a module 22 defining an edge contact sized for receipt in one of the card edge sockets 20, of one of the interconnect locations (column 4, lines 18-29).

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made, for Jennison to include in his invention that the patch panel comprising a module defining an edge contact sized for receipt in one of the card edge sockets, of one of the interconnect locations as taught by Carlson because Carlson teaches that such connectors is adapted to receive a complementarily shaped end portion of a service module.

As to claims 6 and 12: Carlson discloses the patch panel having all of the claimed features as discussed above with respect claim 1(8),

except , Jennison doesn't explicitly teach a power module mounted to the major surface of the back plane 16 and electrically connected to the circuitry.

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Carlson discloses in Fig. 1 a power module 24 mounted to the major surface of the back plane 16 and electrically connected to the circuitry (column 32-38).

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made, for Jennison to include in his invention that a power module mounted to the major surface and electrically connected to the circuitry, as taught by Carlson because Carlson teaches such module provide power to service module (column 4, lines 34-38)

Although, Jennison doesn't explicitly teach that major surface of the patch panel is the back major surface of the patch panel, it has been held In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice).

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made, for Jennison to include in his invention that a power module mounted to the back major surface of the patch panel to provide power to service modules.

As to claims 7 and 13: Carlson discloses the patch panel having all of the claimed features as discussed above with respect claim 1(12),

except , Jennison doesn't explicitly teach a CPU module mounted to the major surface and electrically connected to the circuitry.

Carlson discloses in Fig. 1 control service module 22c mounted to the major surface of the motherboard 16 and electrically connected to the circuitry.

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made, for Jennison to include in his invention that a CPU module mounted to the major surface and electrically connected to the circuitry, as taught by Carlson because Carlson teaches such module can perform a variety of tasks (column 8, lines 49-57).

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Although, Jennison doesn't explicitly teach that major surface of the patch panel is the back major surface of the patch panel, it has been held In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice).

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made, for Jennison to include in his invention that a power module mounted to the back major surface of the patch panel to provide power to service modules.

4.2. Claims 3, 4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennison, as applied to claim 1 and 8 above, and further in view of Carlson and Curry et al. (Patent #6053764) hereinafter Curry.

As to claims 3, 4, 10 and 11: Carlson discloses the patch panel having all of the claimed features as discussed above with respect claim 1(12), wherein one of the pairs of termination locations includes an RJ45 jack,

except , Jennison doesn't explicitly teach one of the pairs of termination locations includes two insulation displacement connectors.

Curry discloses in Fig. 1 one of the pairs of termination locations 18 includes insulation displacement connectors 19 (column 5, lines 22-27).

Therefore it would have been obvious to one of ordinary skill in the art, at time the invention was made, for Jennison to include in his invention that one of the pairs of termination locations includes two insulation displacement connectors, as taught by Curry because Curry teaches such connections can be performed without adapters (column 4, lines 8-18).

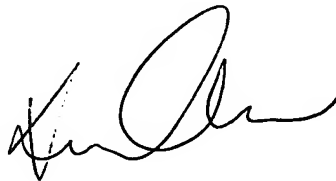
5.1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yuriy Semenenko whose telephone number is (571) 272-6106. The examiner can normally be reached on 8:30am - 5:00pm.

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5.2. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571)- 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

5.3. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YS



K. Cuneo
SPE 2841